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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,783	03/16/2000	Karl Hartmut Sauer	I.G164.186	1623

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09/24/2002

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/526,783

Applicant(s)
Sauer et al.

Examiner
Clark F. Dexter

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3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 4, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-8, and 10-13 is/are pending in the application.
- 4a) Of the above, claim(s) 6, 10, and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 8, 12, and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. The amendments filed March 28, 2002 and July 4, 2002 have been entered. It is noted that in view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

Abstract

2. The substance of the new abstract of the disclosure is acceptable, however the substitute abstract is objected to because the use of italics in lines 4-5 is improper. A replacement abstract is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. Claims 1, 2, 4, 5, 7, 8, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims remain replete with vague and indefinite language

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and should be carefully reviewed. The following are examples of many of the occurrences of such language.

In claim 1, line 3, the recitation “by perforating means” renders the claim vague and indefinite, particularly as to what is being set forth as the claimed invention, and it is suggested in line 3 to delete “perforating means, ”, and in line 5 before “and having” to insert --perforating means supported on the base plate and the die plates, -- or the like; in lines 3-4, “the objects” lacks antecedent basis; in line 9, “the paper punches” lacks positive antecedent basis, and it is suggested in line 7 to change “with the” to --with each--, and in line 9 to change “ends of the paper punches are” to --end of each paper punch is-- or the like for clarity; in lines 10-11, the recitation “the cavity containing the scrap” is vague and indefinite since it appears that the invention is being defined in terms of the workpiece which is not part of the claimed invention, and it is suggested to simply insert --for-- before “containing” or the like.

In claim 4, line 3, “the paper products” lacks antecedent basis.

In claim 5, line 3, “the paper products” lacks antecedent basis.

In claim 7, lines 1-2, “a pressing plate” is vague and indefinite with respect to the recitation of “die plates” in claim 1, and in line 2, “a receiving plate” is vague and indefinite with respect to the recitation of “die plates” in claim 1, and it is suggested in line 1 to insert --the die plates include-- after “wherein”, and in line 2 to insert --which-- before “are” or the like.

In claim 8, line 2, “a guide plate” is vague and indefinite, particularly with respect to the recitation of “die plates” in claim 1, and it is suggested in line 1 to insert --wherein the die plates

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include a guide plate, and -- before “wherein”, and in line 2 to change “a guide” to --the guide-- or the like; in line 2, “the paper punches” lacks positive antecedent basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 4, 5, 7, 8, 12 and 13, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schall et al., pn 4,509,396 in view of Muzik, pn 4,257,300 and Swiss Publication 246681 (hereafter SP ‘681).

Schall et al. discloses a device with almost every structural limitation of the claimed invention as best understood from the claims including a base plate (e.g., 14) and a drive mechanism (e.g., 13). Further, in view of applicant’s remarks, it appears that the perforating means is intended to be considered as part of the claimed invention. Schall et al. discloses such a

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perforating means which includes a hollow paper punch (e.g., 16) wherein the upper end of the punch is open and an exit is directed upwardly, communicating with a storage cavity (e.g., the space between the drive mechanisms). Schall et al. lacks a cutting bushing. However, the Examiner takes Official notice that such cutting bushings are old and well known in the art; for example, Muzik discloses such a cutting bushing (e.g., 5) wherein such cutting bushings provide well known benefits such as providing a wear part that can be easily replaced when it becomes worn or otherwise damaged without having to replace the entire base member (e.g., 11). Therefore, it would have been obvious to one having ordinary skill in the art to provide a cutting bushing on the device of Schall et al. for the well known benefits including that described above.

Further, if it is argued that Schall et al. only discloses a single die plate and is required to disclose a plurality of die plates, the Examiner takes Official notice as stated in the previous Office action that such punch holding and guiding configurations are old and well known in the art, as evidenced by SP '681, and provide various well known benefits including providing separate components for easy manufacturing, maintenance and/or assembly/disassembly. Therefore, it would have been obvious to one having ordinary skill in the art to provide a plurality of die plates on the device of Schall et al. for the various known benefits including those described above.

Further, if it is argued that Schall et al. does not disclose a storage cavity as disclosed, the Examiner takes Official notice that such storage cavities are old and well known in the art as evidenced by SP '681 for providing a collection area for the punched-out material. Therefore, it

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would have been obvious to one having ordinary skill in the art to provide such a storage cavity on the device of Schall for the various known benefits including that described above.

Regarding claims 7, 8, 12 and 13, Schall et al. lacks the specific features of the die plates including a guide plate, a pressing plate, and springs and stops therefor. Further, the combination lacks a support. However, the Examiner takes Official notice that these features are known and are conventional and provide various well known benefits. For example, springs and stops provide well known operational components for punches for both retracting punches and limiting the amount of retraction so as to maintain a desired amount of travel for the punch; supports serving as containers are old and well known as evidenced by SP '681 for receiving scrap from punching devices; die plates including a guide plate and a pressing plate are old and well known as evidenced by SP '681 for providing support structure for punching operations. Therefore, it would have been obvious to one having ordinary skill in the art to provide any or all of these features on the device of Schall et al. for the well known benefits including those described above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3590; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
September 20, 2002